

REMARKS

The amendments are the same amendments that were proposed in the Reply After Final Rejection filed February 1, 2005. These amendments were refused entry in the Advisory Action on the alleged basis that the amendments to claim 10 were not supported in the original disclosure and constituted new matter. **Applicants strongly urge reconsideration.**

Claim 10 was amended to recite that the homogeneous pigment composition comprises: $\geq 40\%$ 50% by weight of one or more effect pigments. The change from $\geq 40\%$ to $\geq 50\%$ merely incorporated the terms of previous claim 26 into claim 10. This finds full support in the disclosure at page 5, lines 27-29, of the original disclosure.

Claim 10 was further amended to recite:

- 0.5 - ~~59.5%~~ 49.5% by weight of a styrene-modified polyacrylate having an acid number > 90 mg KOH/g, and
- 0.5 - ~~50%~~ 49.5% by weight of water.

These changes are simple mathematical necessities in view of the change of the amount of effect pigments in the composition. Although these numbers are not explicitly recited in the original disclosure, it would be immediately apparent to one of ordinary skill in the art that, since the minimum of the amount of effect pigments is raised, the maximum of the amount of the other components must be lowered, i.e., the composition amounts cannot exceed 100%. For example, with the minimum amount of effect pigment being 50% and the minimum amount of styrene-modified polyacrylate being 0.5%, the maximum amount of water can only be 49.5%. Such a mathematical necessity is inherent in the original disclosure and need not be explicitly recited to be supported by the original disclosure. It is well settled that the

specification to satisfy the description requirement of 35 U.S.C. §112, first paragraph. See In re Lukach, 169 USPQ 795 (CCPA 1971); Kennecott Corp. v. Kyocera International, Inc., 5 USPQ2d 1194, 1197 (Fed. Cir. 1987); Martin v. Johnson, 172 USPQ 391 (CCPA 1972); and In re Wertheim, 191 USPQ 90, at 98 (CCPA 1976). An inherent disclosure is sufficient and the recitations of the maximum amounts of styrene-modified polyacrylate and water in the above claims are inherent in the literal disclosure of the preferred embodiment of the minimum amount of effect pigments.

Accordingly, it is urged that the amendments do not introduce new matter.

Further, the amendments should be entered because they direct the claims to the allowable subject matter indicated in the Final Office Action. Thus, the substance of previous claim 26 – indicated to be allowable – is incorporated into claim 10. Claim 19 is written in independent form and claims 20-23 are amended to depend from claim 19. The amendments to claims 19-23 do not change the scope of these claims.

It is submitted that the above amendments would put the application in condition for allowance since they direct the claims to the indicated allowable subject matter. The rejections under 35 U.S.C. §112 and 35 U.S.C. §103 are rendered moot by the amendments. The amendments do not raise new issues or present new matter and do not present additional claims. The amendments were made to direct the claims to the subject matter indicated in the Final Office Action to be allowable. Thus, they were not earlier presented. Accordingly, it is submitted that the requested amendments should be entered.

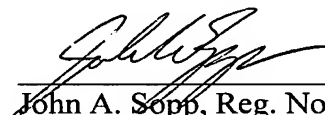
To the extent that the amendments avoid the prior art or for other reasons related to patentability, competitors are warned that the amendments are not intended to and do not limit the scope of equivalents which may be asserted on subject matter outside the literal scope of any patented claims but not anticipated or rendered obvious by the prior art or

otherwise unpatentable to applicants. Applicants reserve the right to file one or more continuing and/or divisional applications directed to any subject matter disclosed in the application which has been canceled by any of the above amendments.

It is submitted that the application is in condition for allowance. But the Examiner is kindly invited to contact the undersigned to discuss any unresolved matters.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,



John A. Sopp, Reg. No. 33,103
Attorney/Agent for Applicants

MILLEN, WHITE, ZELANO
& BRANIGAN, P.C.
Arlington Courthouse Plaza 1
2200 Clarendon Blvd. Suite 1400
Arlington, Virginia 22201
Telephone: (703) 243-6333
Facsimile: (703) 243-6410
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